

**REMARKS****I. General**

Applicant has amended claims 1, 5, 9 and 13. Claims 1-13 and 15-29 are pending in this application. Claims 1, 2, 5-6, 9-10, 13, 15 and 19-29 stand rejected under 35 U.S.C. § 102(e). Claims 3, 4, 7, 8, 11, 12, 17 and 18 stand rejected under 35 U.S.C. § 103(a). Applicant respectfully traverses the rejections of record.

**II. The 35 U.S.C. § 102 Rejections**

Claims 1, 2, 5-6, 9-10, 13, 15 and 19-29 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Number 5,742,905 to Pepe et al. (hereinafter “Pepe”). It is well established that to anticipate a claim under 35 U.S.C. § 102, a reference must teach every element of the claim, see M.P.E.P. § 2131. Applicant respectfully asserts that the disclosure of Pepe does not teach all elements of the claims.

**A. The Independent Claims**

Claim 1, as amended, requires a MailAlert code to alert the subscriber when a characteristic match is found in an email, and to execute instructions received from the subscriber in response to the alert. Pepe describes a network that operates as an interface between various wireless and wireline networks. See, Abstract. Subscriber message receipt and delivery options are maintained in a database which may be accessed and updated by the subscriber. See, *id.* While Pepe does disclose forwarding email based on pre-defined instructions shown in a profile, Pepe does not disclose sending an alert in response to the receipt of an email message that matches characteristics, and executing instructions received from the subscriber in response to the alert.

As shown above, Pepe does not teach all elements of the claim. Moreover, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim” for a disclosure to properly form the basis of a 35 U.S.C. § 102 rejection, see M.P.E.P. § 2131, citing *Richardson v. Suzuki Motor Co.*, 9 U.S.P.Q.2d 1913 (Fed. Cir. 1989). Applicant respectfully asserts that executing instructions received from a subscriber in response to an alert generated when an email matches characteristics pre-stored on the server is not present

in the disclosure of Pepe. Therefore, the 35 U.S.C. § 102 rejection of claim 12 and the claims dependent therefrom should be withdrawn.

Claim 5, as amended, requires an email system and a Mail Alert system adapted to compare characteristics of email messages for the subscriber with specific message characteristics pre-stored on the server, where the Mail Alert system sends an alert when an email matches a characteristic and executes instructions received from the subscriber in response to the alert. As set forth above, Pepe does not disclose receiving instructions from a subscriber for forwarding email in response to an alert generated by a Mail Alert system. Pepe, therefore, does not teach all elements of the claim. Applicant respectfully asserts that executing instructions for forwarding email received from a subscriber in response to an alert, is not present in the disclosure of Pepe. Therefore, the 35 U.S.C. § 102 rejection of claim 5 and the claims dependent therefrom should be withdrawn.

Claim 9, as amended, requires after alerting the subscriber of receipt of an email message for which a characteristic match is found, receiving instructions from the subscriber and then forwarding the email according to the instructions. As stated, Pepe does not show a system that receives instructions in response to sending an alert and then forwards email according to the instructions. As all the limitations of claim 9, as amended, are not present in Pepe, the 35 U.S.C. § 102 rejection of record should be withdrawn.

Claim 13, as amended, requires an agent for processing email which includes a save facility for storing messages against future distribution instructions, the future distribution instructions received from the subscriber in response to the alert from the alert mechanism. As Pepe does not shown future distribution in response to instructions received from the subscriber in response to an alert, the rejection of record under 35 U.S.C. § 102 should be withdrawn.

Claim 19 describes a method which receives a message for a subscriber, sending an alarm to the subscriber if the message matches criteria, receiving a reply from the subscriber in response to the alert, and processing the message according to instructions from the subscriber. As stated, Pepe does not describe a system in which messages are treated based on instructions from a subscriber which are sent directly in response to an alert. With respect

to claim 19, the Examiner has referenced column 29, line 41 through column 30, line 13. The Applicant would point out to the Examiner that the referenced description describes a way for a subscriber to direct incoming phone calls based on caller id information. An incoming telephone call is not a message according to claim 19, further an alert is sent to the subscriber for every telephone call, there is no filtering based on criteria. Any filtering that is done is based on the caller id information, and not the call itself, and it is the call of Pepe that is directed as desired by the subscriber not caller id information. The Examiner cannot force the disclosure of Pepe to meet the limitations of claim 19 without confusing the actual call and the caller id information described in Pepe. Claim 19 has one entity, the message, on which it both make a determination and then forwards, not the separate entities in Pepe. As Pepe does not disclose all the limitations described in claim 19, the rejection of record should be withdrawn.

**B. The Dependent Claims**

Claims 2, 6, 10, 15 and 20-29 depend from their respective independent claim of claims 1, 5, 9, 13 and 19 and include all the limitations thereof, and are therefore asserted to be patentable over the §102(e) rejection of record based upon Pepe at least for the reasons set forth above.

**III. The 35 U.S.C. § 103 Rejections**

Claims 4, 8, 11, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Number Pepe. Claims 3, 7, 12, and 18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Pepe in view of U.S. Patent Number 6,545,589 to Fuller et al. (hereinafter "Fuller").

**A. The Dependent Claims**

Claims 3 and 4 depend from base claim 1, and, therefore, inherit all the limitations of claim 1. As claim 1 is allowable for at least the reasons set forth above, claims 3 and 4 are allowable for at least the reasons set forth with respect to claim 1.

Claims 7 and 8 depend from base claim 5, and, therefore, inherit all the limitations of claim 5. As claim 5 is allowable for at least the reasons set forth above, claims 7 and 8 are allowable for at least the reasons set forth with respect to claim 5.

Claims 11 and 12 depend from base claim 9, and, therefore, inherit all the limitations of claim 9. As claim 9 is allowable for at least the reasons set forth above, claims 11 and 12 are allowable for at least the reasons set forth with respect to claim 9.

Claims 17 and 18 depend from base claim 13, and, therefore, inherit all the limitations of claim 13. As claim 13 is allowable for at least the reasons set forth above, claims 17 and 18 are allowable for at least the reasons set forth with respect to claim 13.

Claims 20-29 depend from base claim 19, and, therefore, inherit all the limitations of claim 19. As claim 19 is allowable for at least the reasons set forth above, claims 20-29 are allowable for at least the reasons set forth with respect to claim 19.

The limitations of claim 16 have not been addressed by the Examiner in the present office action.

#### IV. Summary

In view of the above, each of the pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 66360/P001D1/10402620 from which the undersigned is authorized to draw.

Dated: December 22, 2004

Respectfully submitted,

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